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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86321169
Applicant	Volcano Produce, Inc.
Applied for Mark	GOLDENBERRY
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Serial No. 86321169
Mark: GOLDENBERRY
Applicant: VOLCANO PRODUCE, INC.
Examining Attorney: Michael Eisnach
Law Office 104

EX PARTE APPEAL

APPLICANT'S BRIEF

Dated: Miami, FL
July 8, 2016

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INTRODUCTION

COMES NOW, the Applicant, Volcano Produce, Inc., a Nevada corporation, with a business address in Valencia, California (“Applicant”), by and through its undersigned counsel, to hereby respectfully appeal the Examining Attorney’s refusal to register the Applicant’s word mark, GOLDENBERRY, Application Serial No. 86321169, filed June 26, 2014, in Class 31, for fresh fruits. The literal element of the mark consists of the word GOLDENBERRY. The mark consists of standard characters, without claim to any particular font, style, size, or color.

A Request for Oral Hearing is being filed contemporaneously herewith on behalf of the Applicant, Volcano Produce, Inc., a Nevada corporation.

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DESCRIPTION OF RECORD

A. THE APPLICATION

The Application here at issue, for the name and mark GOLDENBERRY, was filed with USPTO, on behalf of Applicant, on June 26, 2014, just over two (2) years ago. The identified goods are fresh fruits in Class 31 and the subject Application was use-based.

The Application was initially refused, by the Trademark Examining Attorney (the “Examiner”), by Office Action, on October 9, 2014. The aforescribed initial Office Action, which incorporated no less than thirteen (13) attachments by the Examiner, refused registration, sought a specimen and, oddly enough, also contained an Information Request (as described, with greater particularity, *infra*).

The Examiner’s aforementioned refusal was based on Sections 1, 2, and 45 of the Trademark Act, Title 15 U.S. Code §§ 1051-1052, 1127; *see also* Trademark Manual of Examining Procedure (“TMEP”) §1202.12. In barest summary, the Examiner refused registration on the ground that the “applied-for mark was, according to the Examiner, a varietal name for the identified goods and as such, does not function as a trademark to indicate the source of applicant’s goods and to identify and distinguish them from others.” At the same time, however, “to permit proper examination,” the Examiner required Applicant to provide information as to the following two (2) issues: (1) whether “Golden Berry” or “GoldenBerry” has ever been used as a varietal or cultivar name; and (2) whether a plant patent, utility patent, or certificate for plant variety protection exists under such name.

Subsequently, on April 9, 2015, Applicant submitted a specimen to USPTO and, contemporaneously therewith, submitted Applicant's Response to the initial USPTO Office Action bearing date of October 9, 2014. Applicant's Response was over three hundred (300) pages long, including Exhibits "A" through "W," together with an eleven (11) page textual Response.

As part and parcel of said Response, Applicant complied with the Examiner's prior Informational Request and, of course, furnished the Examiner with Applicant's arguments negating the argument that GOLDENBERRY was, or is, a varietal or cultivar name.

Thereafter, on April 29, 2015, the USPTO Examiner issued a second Office Action. Importantly, based upon Applicant's Response (of April 9, 2015), the Examiner stated that he "withdraws the following refusal and requirement: Sections 1, 2 and 45 Varietal refusal and the inquiry regarding the wording in the mark."

Notwithstanding the foregoing, the Examiner, for the first time, then refused registration of the mark in question on two (2) new grounds, *to wit*: (1) mere descriptiveness; and (alternatively) (2) genericness. At the same time, the Examiner required a substitute specimen.

In a timely fashion, on October 29, 2015, Applicant's counsel submitted a substitute specimen to USPTO. Contemporaneously therewith, Applicant submitted to the Examiner a Response to the April 29, 2015 Office Action, which Response included both argument and evidence.

A few weeks later, the Examiner issued a Final Action, on November 18, 2015, refusing registration on grounds of mere descriptiveness and, additionally, genericness. The Examiner noted that Applicant's Response had stated "Argument with Exhibits" under the "Description of

Evidence” Section of the TEAS form, but the Examiner claimed (erroneously) that no arguments were provided. Thus, the Examiner, rather than follow up with Applicant’s counsel or make other pertinent inquiry, simply ignored the problem and the obvious discrepancy and steamed full-speed ahead in his haste to issue a Final Refusal.

Applicant’s counsel brought the problem to the Examiner’s attention. The Examiner supposedly checked with USPTO’s I/T people; at the end of the day, he blamed the episode on a “computer glitch.”

In any event, in light of the above-recounted, precipitous action by the Examiner, the Applicant filed a Request for Reconsideration on January 11, 2016. All of the arguments, and Exhibits, that had previously been forwarded by Applicant to USPTO on October 29, 2015, were sent, once again, by virtue of the January 11, 2016 Request for Reconsideration. (Appendix “B” thereof was a fresh copy of Applicant’s October 29, 2015 Response, which, in turn, included the entirety of Exhibits “A”-“D”.)

Approximately three (3) weeks later, the Examiner, by Office Action dated February 1, 2016, flatly denied Applicant’s Request for Reconsideration. In the context of said latest refusal, the Examiner stated that the Section 2(e)(1) refusal is maintained and continues to be final. He further stated that “the mark is refused under Section 2(e)(1) of the Trademark Act and not Section 23(c).”

Notwithstanding the foregoing, in the earlier Office Action of April 29, 2015, the Examiner had stated “the applied for mark appears to be generic. . .” That conclusion by the

Examiner was also repeated in his November 18, 2015 “Final” Office Action.¹ Out of an abundance of caution, therefore, Applicant feels compelled to, and shall, address both issues in the body of this Brief.

As a postlude to the Examiner’s final refusals and, later, the denial of Applicant’s Request for Reconsideration, Applicant was constrained to lodge the instant appeal. The Notice of Appeal herein was timely filed by Applicant on May 13, 2016.

The Trademark Trial and Appeal Board (“TTAB”) of USPTO acknowledged the appeal and issued an order instituting same on even date therewith.

B. EXAMINING ATTORNEY’S EVIDENCE

Albeit the Examiner submitted thirteen (13) attachments to the Initial Office Action (of October 9, 2014), inasmuch as the Examiner later, on April 29, 2015, withdrew the refusal based on Sections 1, 2, and 45, Applicant respectfully contends that the Examiner’s attachments (evidence) to the Initial Office Action now are moot and, they are rendered nugatory.

As for the Examiner’s Second Office Action, there were fifty-eight (58) attachments

¹ As recounted herein, the Examiner on this file initially rejected the mark at issue as a cultivar or varietal name. When the Applicant persuaded the Examiner that he had erred, the Examiner then withdrew that cultivar-related grounds for rejection. At the same time, he raised new grounds that allegedly supported a rejection (*i.e.*, descriptiveness and genericness). It appears from the Examiner’s Office Actions and other official communications that the Examiner’s refusal was also based on both (alleged) descriptiveness and genericness. In the last writing, the denial of Applicant’s Request for Reconsideration, the Examiner appears to have back-tracked on the generic issue. However, this vagueness and the apparent contradictions afford little or no comfort to Applicant. The Applicant, which has already been involved in a more than two (2) year process herein, is entitled to a clear set of rulings and a clear record. Applicant does not wish to be confronted by a scenario wherein it prevails on the instant appeal only to have the Examiner, then, fall back on and claim that the genericness rejection still exists and rules the day in any event. If appropriate, the TTAB should remand the case to the Examiner for explanation, clarification, and further consideration. *See* TMEP § 1209.01, 37 CFR § 2.142(f)(1).

(pages) in alleged support of the Examiner's more recently divined "merely descriptive" refusal of the instant Application. The Examiner's evidence consists primarily of: an excerpt from a U.S. patent document; an excerpt from a food dictionary; an excerpt from Applicant's website; copies of certain articles derived from various and sundry internet websites (*e.g.*, Amazon, Global Healing Center, Raw Guru, and Pop Sugar); and an article from "Wikipedia."

In his Final Office Action, dated November 18, 2015, the Examiner attached sixty-seven (67) pages, consisting mainly of an additional potpourri of internet articles (*e.g.*, People.com, Huffpost, Fox News Latino, East Bay Express, and Gardenate).

In the context of the Examiner's Reconsideration Letter, dated February 1, 2016, there were fifty (50) pages attached, comprised mainly of Webster and Oxford dictionary excerpts, as well as certain internet articles (*e.g.*, Food Processing, The Economic Times, Nutra Ingredients.com, International Business Times, and the Vermont Garden Journal).

C. APPLICANT'S EVIDENCE

In Response to the Initial Office Action, the Applicant submitted, *inter alia*, evidence comprised of internet websites and articles (*e.g.*, The Cape Gooseberry, Incredible Edibles, CapeGooseberry.com, TheKitchen.com), patent searches for "Golden Berry" and "Uchuva," copies of U.S. Patents relating to the "Gooseberry" or "Cape Gooseberry," and copies from the database of the U.S. Department of Agriculture's ("USDA") Plant Variety Protection Office.

As to Applicant's October 29, 2015 Response, Applicant submitted as evidence, *inter alia*, the USDA's Fresh Fruit and Vegetable Manual (List of Approved Names), and an article from GardeningChannel.com ("List of Types of Berries from A to Z").

Incorporated into its Request for Reconsideration, Applicant re-submitted Exhibits “A” through “D” from its October 29, 2015 Response. (*See* discussion, *supra*.)

STATEMENT OF ISSUES

1. Whether the Applicant’s mark, *to wit*, GOLDENBERRY, is merely descriptive of the goods? *See* Title 15 U.S.C. §1052(e)(1); Lanham Trademark Act, Section 2(e)(1); *see also* TMEP §1209.01(b), 1209.03 *et seq.*; and

2. Whether the Applicant’s *aforecited* mark, GOLDENBERRY, is generic in connection with the identified goods? *See* TMEP §§1209.01(c), *et seq.*, 1209.02(a).

ARGUMENT

Applicant respectfully submits that the Examiner has erred. The mark here under consideration, GOLDENBERRY, is not merely descriptive. It hardly seems necessary to add that the mark also decidedly is not generic.

As a threshold matter, generic terms are common words or names (frequently found in the dictionary), that identify products or services which are not specific to any particular source (*e.g.*, aspirin, cellophane, elevator, escalator, automobile, linoleum, lite, magazine, super glue, vaseline, and yellow cab). Suffice it to say that a generic term can never function as a trademark. Thus, to allow a government monopoly on a generic term would be adverse to the public interest in promoting free and fair competition:

“To allow trademark protection for generic terms, *i.e.*, names which describe the genus of goods being sold, even when these have become identified with a first user, would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.”

CES Publ’g Corp. v. St. Regis Publ’ns, Inc., 531 F.2d 11, 13 (2d Cir. 1975).

In barest summary, then, as a practical matter, generic terms and trademarks cannot co-exist. “In short, a generic name of a product can never function as a trademark to indicate origin. The terms ‘generic’ and ‘trademark’ are mutually exclusive.” J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition*, Vol. 2, § 12:1, at p. 12-4 (4th ed. 2007); *see also* Restatement (Third) of Unfair Competition § 15.

The Examiner herein has seriously questioned, if not asserted, that the mark at issue is generic in nature. GOLDENBERRY clearly does not fall into the generic category. Furthermore, it would appear that the Examiner, in persisting in this line of argument is indirectly and improperly attempting to resurrect the earlier, flawed (and, later, withdrawn) varietal argument.

The Examiner, of late, contends that GOLDENBERRY is merely descriptive. That contention, likewise, is wholly devoid of merit.

Generally speaking, descriptive marks describe the goods or a characteristic, quality, purpose, component, or other property of the goods. A mark is deemed to be descriptive if it forthwith conveys an immediate idea of the ingredients, qualities, or characteristics of the goods. *See Stix Prods., Inc. v. United Merchs. & Mfrs., Inc.*, 295 F. Supp. 479, 487-88 (S.D.N.Y. 1968). Some examples of descriptive marks include, but are not limited to, the following: HONEY-BAKED (for hams), ICE (for beer), L.A. (for low-alcohol beer), and VISION CENTER (for optical clinics).

The mark here at issue, GOLDENBERRY, is to be sure, inherently distinctive. It is not merely descriptive. It is not generic (*see* discussion, *supra*). Thus, no secondary meaning is required. “The latter three categories of marks [suggestive, arbitrary & fanciful] because their

intrinsic nature serves to identify a particular source of a product, are deemed inherently distinctive and are entitled to protection.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 112 S. Ct. 2753, 2757, 23 U.S.P.Q.2d 1081, 1083 (1992).

For the vast majority of courts, the proper placement of a mark on the spectrum of trademark distinctiveness is a factual issue. The legal standard is clear error. *See, e.g., In re Kwik Lok Corp.*, 217 U.S.P.Q. 1245, 1983 WL 51790, at *2 (T.T.A.B. 1983); *see also In Re Bed & Breakfast Registry*, 791 F.2d 157, 160, 229 U.S.P.Q. 818 (Fed. Cir. 1986).

It is beyond debate that the common law has long embodied the rule that terms that are merely descriptive of the qualities, ingredients, or characteristics of a product cannot be protected as “technical” trademarks. *Canal Co. v. Clark*, 80 U.S. 311, 317, 20 L. Ed. 581 (1872). Stated otherwise, a ‘descriptive’ term is one that directly and immediately conveys some knowledge of the characteristics of a product or service. *In re MBNA America Bank, N.A.*, 340 F.2d 3d 1328, 1332, 67 U.S.P.Q.2d 1778 (Fed. Cir. 2003), *reh’g and reh’g en banc denied*, (Fed. Cir. 2004).

For example, the term or name, OATNUT, for bread, immediately tells us that the bread contains nuts and oats. *In re Entenmann’s Inc.*, 15 U.S.P.Q. 2d 1750, 1990 WL 354520, at *2 (T.T.A.B. 1990) (name informs buyers, with the required degree of particularity, the 2 important ingredients).

Thus, we may pause to observe the following additional illustrations of marks held to be descriptive: *In re Wileswood, Inc.*, 201 U.S.P.Q. 400 (T.T.A.B. 1978) (AMERICA’S BEST POPCORN! (for popcorn)); *Milwaukee Nut Co. v. Brewster Food Serv.*, 277 F.2d 190, 125 U.S.P.Q. 399 (C.C.P.A. 1960) (BEER NUTS (for salted nuts); *Eagle Snacks, Inc. v. Nabisco Brands, Inc.*, 625 F. Supp. 571, 228 U.S.P.Q. 625 (D.N.J. 1985) (HONEY ROAST (for nuts

roasted with honey)); *In re General Foods Corp.*, 177 U.S.P.Q. 403 (T.T.A.B. 1973) (PUDDING TREATS (for pudding desserts); and *Skinner Mfg. Co. v. Kellogg Sales Co.*, 143 F.2d 895, 62 U.S.P.Q. 324 (8th Cir. 1944), *cert. den.*, 323 U.S. 766, 65 S. Ct. 119, 63 U.S.P.Q. 359 (1944) (RAISIN BRAN (for bran cereal with raisins)) .

In marked contrast, if the information about a product or good is vague or indirect, then, the term is suggestive, not descriptive. A good example would be POLY PITCHER, for polyethylene pitchers. That name was held, by an appellate tribunal, to be an incongruous expression of characteristics or a coined or fanciful mark. *Blisscraft of Hollywood v. United Plastics, Co.*, 294 F.2d 694, 131 U.S.P.Q. 55 (2d Cir. 1961). In that vein, SWEETARTS, for candy goods, was yet another name judicially held to be non-descriptive. *Sweetarts v. Sunline, Inc.*, 80 F.2d 923, 154 U.S.P.Q. 459 (8th Cir. 1967).

The burden of proof in such matters can, of course, be discharged through circumstantial evidence of the relevant public's understanding (*e.g.*, newspapers, magazines, trade journals other publications). No survey is required.

The quintessential inquiry, therefore, is, what does the mark mean to prospective customers? “A term should be characterized as ‘descriptive’ only if a substantial portion of prospective customers recognize it as such.” McCarthy on Trademarks & Unfair Competition §11.20, p. 11-32. (Emphasis added.) (*See also Blisscraft, supra* [the number of people that understood “poly” to be synonymous with polyethylene was inconsequential].)

To reinforce the point, “[t]he meaning of a term to a non-purchasing segment of the population is neither relevant nor important.” McCarthy on Trademarks & Unfair Competition § 11.20, at p. 11-32; *see also Blisscraft, supra*. Dictionary definitions, concededly, are relevant.

Hancock v. American Steel & Wire Co., 203 F.2d 737, 740, 97 U.S.P.Q. 330 (C.C.P.A. 1953).

However, it would be well to remember that relevant is not synonymous with dispositive. This is just one more type of evidence that comprises the overall corpus of proof. To be sure, the line of demarcation between descriptive marks and suggestive marks is not always an easy one to draw. As Professor McCarthy sagely has observed: “If a quantitative survey of all marks were taken,” it would probably show that a substantial part, if not a majority, of all marks are suggestive of the product to some extent.” McCarthy, *supra*, § 11:65, at p. 11-126.5.

Picture, if you will, a buffer (or twilight zone) betwixt the purely fanciful marks and the descriptive marks.

“Between these two extremes lies a middle ground wherein terms of mingled qualities are found. It cannot be said that they are primarily descriptive or that they are purely arbitrary or fanciful without any indication of the nature of the goods which they denominate. Such terms, indeed, shed some light upon the characteristics of the goods, but so applied they involve an element of incongruity, and in order to be understood as descriptive, they must be taken in a suggestive or figurative sense through an effort of the imagination on the part of the observer.”

McCarthy, *supra*, § 11:64, at p. 11-126.4; *see also General Shoe Corp v. Rosen*, 111 F.2d 95, 45 U.S.P.Q. 196 (4th Cir. 1940), *reh’g denied*, 112 F.2d 561, 45 U.S.P.Q. 590 (4th Cir. 1940).

Indeed, the Fifth Circuit has described a four-prong test for descriptiveness. The test may be fairly stated as followed: (1) dictionary definition; (2) imagination test; (3) competitors’ need test; and (4) competitors’ use test. *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 792-93, 217 U.S.P.Q. 988 (5th Cir. 1983).

Professor McCarthy, for his part, suggests a tripartite test. The TTAB, in turn, has adopted Professor McCarthy’s test, *to wit*: 1) degree of imagination; 2) competitors’ use; and 3) competitors’ need. McCarthy, *supra*, § 11:67, at p. 11-127; *see also No Nonsense Fashions, Inc.*

v. Consolidated Foods Corp., 226 U.S.P.Q. 502, 1985 WL 72081, at *5 (T.T.A.B. 1985).

As for the “imagination test,” the seminal case is *Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479, 488, 160 U.S.P.Q. 777 (S.D.N.Y. 1968):

“A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods. A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.”

While prior decisions are not binding on this tribunal, they certainly can serve as guidance. Consequently, set forth below is an illustrative list of marks held to be non-descriptive and merely suggestive: *In re Classic Beverage Inc.*, 6 U.S.P.Q. 2d 1383, 1988 WL252481 (T.T.A.B. 1988) (CLASSIC COLA (for soft drinks)); *Johnston Foods, Inc. v. Carnation Co.*, 159 U.S.P.Q. 624, 1968 WL 8197 (T.T.A.B. 1968) (FRUIT SUNDAE (for yogurt)); *Orange Crush Co. v. California Crushed Fruit Co.*, 297 F. 892 (D.C. 1924) (ORANGE CRUSH (for orange drinks)); *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694 (2d Cir. 1961) (POLY PITCHER (for polyethylene pitchers)); *Colgate-Palmolive Co. v. The House for Men, Inc.*, 143 U.S.P.Q. 159, 1964 WL 7981 (T.T.A.B. 1964) (RAPID SHAVE (for shaving cream)); *Sweetarts v. Sunline, Inc.*, 80 F.2d 923, 154 U.S.P.Q. 459 (8th Cir. 1967) (SWEETARTS (for candy)); *Levi Stauss & Co. v. R. Josephs Sportswear*, 28 U.S.P.Q. 2d 1464, 1993 WL 444262 (T.T.A.B. 1993) (ACTION SLACKS (for pants)); *In re Colgate-Palmolive Co.*, 149 U.S.P.Q. 793, 1966 WL 7378 (T.T.A.B. 1966) (HANDI WIPES (for dusting cloths)); *Minnesota Mining & Mfg. Co. v. Johnson & Johnson*, 454 F.2d 1179, 172 U.S.P.Q. 491 (C.C.P.A. 1972) (SKINVISIBLE (for transparent medical adhesive tape)); *Glamorene Products Corp. v. Boyle-Midway, Inc.*, 188 U.S.P.Q. 145, 1975 WL 21166 (S.D.N.Y. 1975) (SPRAY N’ VAC (for aerosol rug cleaner); and

Capitol Tie Rack, Inc. v. Tie Rack Stores, Inc., 150 U.S.P.Q. 357, 1966 WL 7642 (N.D. Ill. 1966)
(TIE RACK (for ties and accessories)).

The mark which forms the basis of this appeal, GOLDENBERRY, more properly ought to be characterized as falling within the penumbra of the “suggestive” sort of classification of marks. A fair degree of one’s imagination is required to make the leap from the mark to what goods are involved.

The fruit is a berry, but it is yellow in color. There is no color “golden.” There is no Pantone® color “golden.” The term “golden” is used as an adjective, but not as a color itself. “Golden” means of, or relating to, gold. (It can also refer to certain geographic places (*e.g.*, Golden, Colorado/Idaho/Texas/Illinois/Missouri/Nebraska, New Mexico/Oregon/Texas and Utah. Thus, the imagination must be used by a prospective purchaser, as the name is suggestive.

Moreover, the overwhelming majority of evidentiary materials submitted by Applicant makes it clear that Cape Gooseberry is the common name for this fruit. Furthermore, the Examiner has collected a hodge-podge of non-academic articles, along with a “Wikipedia” entry, the latter of which clearly is not a scholarly, peer-reviewed article. Moreover, the Examiner points to no supporting survey evidence to the contrary.

More crucially, perhaps, Applicant’s counsel has duly searched amongst the records of the U.S. Department of Agriculture (“USDA”), like USPTO, a federal government agency. If the name GOLDENBERRY was either the generic term or descriptive for a type of fruit, surely, the USDA would know and recognize that and, moreover, such fact would clearly be reflected in the USDA’s official materials. Yet, lo and behold, it is not!

Indeed, the USDA's Fresh Fruit and Vegetables Manual makes absolutely no reference to GOLDENBERRY on the USDA's List of Approved Names. (See excerpt from Table 6-7, List of Approved Names – G Listings, at page 6-43 (2012 Ed.), a true and correct copy of which Manual was annexed as Exhibit "A" to Applicant's October 29, 2015 Response. Albeit "Golden-apple" and "Goldenseal" made the list, "GOLDENBERRY" did not. For the sake of comprehensiveness, the USDA Listing for Cape Gooseberry also was reviewed; again, there was absolutely no mention of, or cross-reference to, "GOLDENBERRY." (*Id.*, at p. 6-21.)

While USPTO is an expert in patent and trademark matters, it is the USDA that ought to be looked to in matters of agriculture and agricultural jargon. Accordingly, in this regard, and in this matter, the USPTO should defer to the expertise of its sister agency, the USDA.

When the descriptive nature of a term is not known to the general purchasing public that, too, is a sign of suggestiveness. For example, the "POLY" in POLY PITCHER was known in the trade as an abbreviation for polyethylene, the plastic composition of the picture. However, that abbreviation was not commonly known to the public. See *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 701-02 (2d Cir. 1961). In the matter at hand, the Applicant's mark, GOLDENBERRY, may be deemed suggestive of the fruit goods at issue, but certainly does not rise to the level of being merely descriptive of same. To be sure, there are many kinds of berries and, as discussed, *infra*, many are yellow or golden in color.

As a matter of objective fact, there are, indeed, numerous types of berries with the same or similar coloration. To illustrate, in the category of red berries, there are numerous types of red berries including, but not limited to: the Baneberry, the Barbados Cherry, the Bearberry, the Buffalo Berry, the Bunchberry, the Cowberry, the Cranberry, the Currant, the Goji Berry, the

Grape, the Holly Berry, the Lingonberry, the Mistletoe Berry, the Raspberry, the Red Mulberry, the Salmonberry, the Strawberry, and the Yew Berry. *See* article entitled “List of Types of Berries from A to Z,” retrieved from www.gardeningchannel.com, on October 21, 2015, a true and correct copy of which is attached as Exhibit “B” to Applicant’s October 29, 2015 Response. Would the Examiner properly refer to any of them, generically, as the “red berry” or the “crimson berry”? No, of course not. Besides, apart from color, there are distinct difference in taste, tartness, tactility, acidity, and even toxicity to human consumers.

Similarly, there are quite a number of different berries that are yellow in color. Such yellow berries include, without limitation: the Guava, the American Persimmon, the Surinam Cherry, the Cape Gooseberry (or *Physalis Peruviana*) (which is the berry here at issue), the Yellow Raspberry, the Tomato, the Chili Pepper, the Western Soapberry, and the Chinaberry. *See* article entitled “10 Plants with Yellow Berries,” retrieved from www.homeguides.sfgate.com, on October 21, 2015, a true and correct copy of which is attached as Exhibit “C” to Applicant’s October 29, 2015 Response. An additional example of a yellow berry is the Yellow Wonder Alpine Strawberry (*see* article entitled “How Sweet it is: Yellow Wonder Alpine Strawberries,” retrieved from www.gardenbetty.com, on October 21, 2015, a true and correct copy of which is attached as Exhibit “D” to Applicant’s October 29, 2015 Response.

Furthermore, as can clearly be seen from the aforementioned Exhibits, not all yellowish berries are edible. In fact, some are quite toxic. In fact, just as is the case with the dichotomy between venomous and non-venomous serpents, there is a simple mnemonic device which outdoorsmen and herbalists use in order to distinguish the edible plants and herbs from the poisonous varieties:

White and yellow, kill a fellow. Purple and blue, good for you.
Red. . . could be good, could be dead. (Emphasis added.)

Clearly, all yellow berries are not even edible. This fact, too, augurs against lumping all yellow colored berries into the same generic, or descriptive, basket.

Therefore, for the Examiner to attempt to describe GOLDENBERRY as either generic or descriptive for a yellow-colored berry simply holds no water, either legally, botanically, factually, commercially, or from the proven perspective of the prospective purchasers.

Finally, it is noteworthy that competitors do not need to use the name or term or mark GOLDENBERRY, to describe their goods. As many third parties do, and as the technical and academic texts do, the berry is commonly referred to as the “Gooseberry” or “Cape Gooseberry” or *Physalis Peruviana*,” while GOLDENBERRY is Applicant’s name for such berries.

CONCLUSION

The Examiner has failed to meet his burden to demonstrate that the Applicant’s name and mark, GOLDENBERRY, is merely descriptive or, in the alternative, generic. Consequently, the TTAB should reverse the Examiner and remand the file to Law Office 104, with instructions to allow registration of the subject mark, GOLDENBERRY.

Predicated upon the foregoing discussion and analysis, Applicant, Volcano Produce, Inc., hereby respectfully requests that the Board grant the instant *Ex Parte* Appeal and allow registration of the Applicant’s mark, GOLDENBERRY, on the Principal Register maintained by the USPTO, which registration hereby earnestly is solicited.

Dated: Miami, FL
July 8, 2016

Respectfully submitted,

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that I caused a copy of the foregoing document to be served on the Commissioner for Trademarks, TTAB, USPTO, 2900 Crystal Drive, Arlington, VA 22202-3513, by electronic filing (ESTTA) on this 8th day of July, 2016.

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